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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/621,289	07/17/2003	Richard W. Ragan JR.	RSW920030060US1	2496
45541 7590 11/15/2007 HOFFMAN WARNICK & DALESSANDRO LLC 75 STATE ST 14TH FLOOR ALBANY, NY 12207			EXAMINER THERIAULT, STEVEN B	
			ART UNIT 2179	PAPER NUMBER
			MAIL DATE 11/15/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/621,289

Applicant(s)

RAGAN ET AL.

Examiner

Steven B. Theriault

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 August 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

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DETAILED ACTION

1. This action is responsive to the following communications: RCE filed 09/05/2007
2. Claims 1 -25 are pending in the case. Claims 1, 11, 14, and 20 are the independent claims. The applicant is advised that a new examiner has been assigned to the case.

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 09/05/2007 has been entered.

Claim Rejections - 35 USC § 101

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 20-25 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The language of the claims raise a question as to whether the claims are directed merely to an abstract idea that is not tied to a technological art, environment or machine which would result in a practical application producing a concrete, useful and tangible result to form the basis of statutory subject matter under 35 U.S.C. 101.

With regard to **claims 20-25**, the computer-program product is defined in the specification as follows:

[0037] It is understood that the present invention can be realized in **hardware, software, or a combination of hardware and software**. Any kind of computer/server system(s)--or other apparatus adapted for carrying out the methods described herein--is suited. A typical combination of hardware and software could be a general-purpose computer system with a computer program that, when loaded and executed, carries out the respective methods described herein. Alternatively, a specific use computer, containing specialized hardware for carrying out one or more of the functional tasks of the invention, could be utilized. The present invention can also be embedded in a **computer program product**, which comprises all the respective features enabling the implementation of the methods described herein, and which--when loaded in a computer system--is able to carry out these methods. Computer program, software program, program, or software, in the present context mean any expression, in any language, code or notation, of a set of instructions intended to cause a system having an information processing capability to perform a particular

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function either directly or after either or both of the following: (a) conversion to another language, code or notation; and/or (b) reproduction in a different material form.

The Examiner interprets the specification as including alternative embodiments where the program product does not include the storage medium, as the specification does not specifically recite that the product **does** include the medium or structure (e.g. processor). The specification states the invention **can** be realized in software, hardware, or both and then goes on to state that the embedded product comprises all of the respective features disclosed herein. While respective embodiments can include hardware and software, one of the embodiments can simply be the software. The claims do not recite the structure where it is clear from interpretation that the structure of the product includes the computer readable medium, processor and display step for actually realizing the transformation from code to make the claim an article of manufacture rather than software per se. Therefore, consistent with MPEP 2106, the claimed subject matter is not currently believed to be limited to that which falls within a statutory category of invention, because it is not limited to a process, machine, manufacture, or a composition of matter.

To expedite a complete examination of the instant application the claims rejected under 35 U.S.C 101 (nonstatutory) above are further rejected as set forth below in anticipation of applicant amending these claims to place them within the four statutory categories of invention.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. **Claims 1 – 4, 6- 25 are rejected under 35 U.S.C. 102(b) as being anticipated by Schacher et al. (Hereinafter Schacher) U.S. Patent No. 6002402 issued Dec. 14, 1999.**

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In regard to **Independent claim 1**, Schacher teaches a method of customizing a user interface the method (See Figure 3) comprising:

- Identifying a user of the user interface (see column 6, lines 20-31, Figure 3, My File, column 7, lines user- preferences, column 14, lines 20-31). Schacher teaches a process of identifying the user in several sections to tailor the shortcuts to user preferences, sending email, and naming files to the users specification.
- Displaying an object within the user interface (Schacher figure 3 and 6). Schacher expressly discloses displaying an object within the interface, such as Iconis, windows, menu, etc that are objects within the interface.
- Displaying a plurality of shortcuts for the object based on the user and a history of the object operations performed by the user to manage the object, wherein at least one shortcut of the plurality of shortcuts comprises a control for managing data in an application. (Schacher column 4, lines 15-31 and column 12, lines 7-20 and column 15, lines 45-67 and column 16, lines 45-67 and figures 3 and 6). Schacher expressly teaches displaying several shortcuts on the desktop, where icons on the desktop can manage data for a given application (See column 5, lines 20-55).

With respect to **dependent claim 2**, Schacher teaches the method wherein the plurality of shortcuts comprises one of: a hyperlink, a button, an icon, a toolbar control, and a menu item (See column 2, lines 35-50). Schacher teaches the shortcuts are icons.

With respect to **dependent claim 3**, Schacher teaches the method wherein the object comprises one of a data file and a set of related data within a data file (Schacher column 19, lines 25-30 and 55-67). Schacher teaches the object can be an icon representing a file for a data processing application such as a word processor or spreadsheet application.

With respect to **dependent claim 4**, Schacher teaches the method further comprising recording object operations that are performed by the user on the object to create the history of object

operations (See Figure 3 and column 20, lines 10-27 and column 16, lines 40-67). Schacher teaches at least two processes of recording the history of the object. One process shows the history of operations from the history option and a macro that can be used to record a users action and then play back the options for the user.

With respect to **dependent claim 6**, Schacher teaches the method further comprising managing the object using an application wherein the displayed shortcut is further based on the application (See column 15, lines 45-52 and column 20, lines 29-60).

As to **dependent claims 7, 17 and 23**, Schacher teaches the method wherein the object has one of a plurality of object states and wherein the displayed shortcuts are further based on object state (Schacher Figure 6). Schacher teaches a variety of object states where the icons shown on the desktop are shown with a given object state (e.g. start-up of a task, saved tasks, copy state etc.

With respect to **dependent claim 8**, Schacher teaches the method wherein the user has a user attribute and wherein the displayed shortcut are further based on a history of object operations selected by a set of users having the user attribute (column 7, lines 25-37).

With respect to **dependent claim 9**, Schacher teaches the method wherein the object has an object attribute and wherein the displayed shortcut is further based on a history of object operations selected for a set of objects having the object attribute (See column 17, lines 59-67 and column 18, lines 1-15). Schacher teaches that drag and dropped item (icon) can be a history file of operations that can be processed by an application.

With respect to **dependent claims 10 and 13**, Schacher teaches the method further comprising reserving a portion of the display area of the user interface for displaying shortcuts wherein the shortcuts are displayed in the reserved portion (Schacher Figure 6). Schacher shows a task bar

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where the shortcuts are displayed which can be a reserved area because task bars are known in the common art to display icons for applications (See column 16, lines 1-5, 630).

In regard to **Independent claim 11**, Schacher teaches the method of customizing a user interface the method comprising:

- Identifying a user of the user interface (See column 6, lines 20-31, Figure 3, My File, column 7, lines user- preferences, column 14, lines 20-31). Schacher teaches a process of identifying the user in several sections to tailor the shortcuts to user preferences, sending email, and naming files to the users specification.
- Displaying an object within the user interface, wherein the object has an object attribute (Schacher figure 3 and 6). Schacher expressly discloses displaying an object within the interface, such as Icons, windows, menu, etc that are objects within the interface. Each object has an attribute such as a file name, expressed attribute such as a file directory name, or can be used with a specific application.
- Recording object operations that are performed by the user on the object to manage the object in a history of object operations (Schacher column 16, lines 45-67). Schacher teaches a macro playback feature that records user choice that can be played back.
- Displaying a plurality of shortcuts for the object based on the user, the object attribute, and a history of the object operations performed by the user to manage the object, wherein at least one shortcut of the plurality of shortcuts comprises a control for managing data in an application. (Schacher column 4, lines 15-31 and column 12, lines 7-20 and column 15, lines 45-67 and column 16, lines 45-67 and figures 3 and 6). Schacher expressly teaches displaying several shortcuts on the desktop, where icons on the desktop can manage data for a given application (See column 5, lines 20-55). Schacher specifically teaches that each object has user-defined properties or attributes (See column 7, lines 23-40).

With respect to **dependent claim 12**, Schacher teaches the method further comprising managing the object using an application wherein the displayed shortcut are further based on the application (See column 15, lines 45-52 and column 20, lines 29-60).

In regard to **Claims 14-16**, claims 14-16 reflect the system comprising computer readable instructions for performing the steps of method claims 11-12, respectively, and are rejected along the same rationale.

With respect to **dependent claim 18**, Schacher teaches the method wherein the user has a user attribute and wherein the displayed shortcuts are further based on a history of object operations selected by a set of users having the user attribute (See column 15, lines 45-52 and column 20, lines 29-60). Schacher teaches the user can create a shortcut for sending an email and the icon can have a set of predefined user properties (See column 7, lines 23-37).

With respect to **dependent claim 19**, Schacher teaches the method wherein the object has an object attribute and wherein the displayed shortcut is further based on a history of object operations selected for a set of objects (See Figure 3 and column 20, lines 10-27 and column 16, lines 40-67). Schacher teaches at least two processes of recording the history of the object. One process shows the history of operations from the history option and a macro that can be used to record a users action and then play back the options for the user. Schacher teaches that every object has user-defined properties (See column 7, lines 23-37).

In regard to **Claims 20-22**, claims 20-22 reflect the program product comprising computer readable instructions for performing the steps of method claims 11-12, respectively, and are rejected along the same rationale.

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With respect to **dependent claim 24**, claim 24 incorporates substantially similar subject matter as claimed in claim 18, and is respectfully rejected along the same rationale.

With respect to **dependent claim 25**, claim 25 incorporates substantially similar subject matter as claimed in claim 19, and is respectfully rejected along the same rationale.

Claim Rejections - 35 USC § 103

3. **The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:**

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Schacher et al.

(Hereinafter Schacher) U.S. Patent No. 6002402 issued Dec. 14, 1999, in view of Roth et al. (6266060) issued July 24, 2001 and filed July 23, 1998.

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With respect to **dependent claim 5**, as indicated in the above discussion, Schacher teaches every limitation of claim 1.

Schacher does not expressly teach calculating a frequency that each object operation was selected by the user, and determining a particular object operation having the highest frequency.

However, Roth teaches a process of capturing recency of selection, frequency time of day and settings with regard to users accessing content and presenting an interface control (menu) with the highest frequency items at the top of the list (See column 9, lines 30-35 and column 10, lines 20-35 and column 11, lines 35-67). Roth and Schacher are analogous art because they both teach a process of manipulating menu selections and recording the history of user selection. Further, they both teach a process of showing a users favorites list from within a browser.

Accordingly, it would have been obvious to one of ordinary skill in the art at the time of the invention, having the teachings of Schacher and Roth in front of them, to modify the system of Schacher to incorporate the history tracking control for the purposes of aiding the user in determining how they arrived at the location in which they chose to mark a website a favorite web page and to add the frequency calculation allowing the most frequently accessed object to be displayed to the user. The motivation Schacher and Roth comes from the suggestion in Roth and Schacher to provide to the user a mechanism to search previously archived search histories (History files and Macros) and to have a record of the users past events while interacting with the browser locations and also to provide a mechanism to display on the interface the frequency of particular selections made by the user (See Roth column 1, lines 42-55 and column 2, lines 25-41).

Response to Arguments

Applicant's arguments with respect to claims 1-25 have been considered but are moot in view of the new ground(s) of rejection.

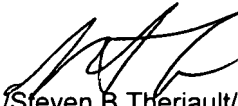
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Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steven B. Theriault whose telephone number is (571) 272-5867. The examiner can normally be reached on M, W, F 10:00AM - 8:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Weilun Lo can be reached on (571) 272-4847. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


/Steven B Theriault/
Patent Examiner
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